

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 25-33, 35-36, and 39-46 are pending after entry of the amendments set forth herein.

Claims 25, 28, 29, 31, and 35 are amended. Support for the amendments can be found in the claims as originally filed and throughout the specification at, for example, page 17, line 3, through page 18, line 29.

New claims 45 and 46 are added. Support for these new claims can be found as in the claims as originally filed and previously presented.

Claims 34, 37, and 38 are canceled without prejudice.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

Allowable Subject Matters

Applicants acknowledge with gratitude the Examiner's indication that claims 35, 39, 40, 43, and 44 are allowable.

Information Disclosure Statements

IDS Filed May 20, 2003

Applicants respectfully request that the Examiner consider the references cited in the Information Disclosure Statement filed on May 20, 2003, and indicate such consideration by initialing the PTO from SB/08A and returning a copy of the initialed form with the next Action.

IDS Filed Herewith

Applicants further respectfully request that the Examiner consider the references cited in the Information Disclosure Statement filed with this communication, and indicate such consideration by initialing the PTO from SB/08A and returning a copy of the initialed form with the next Action.

Rejection Under §112, ¶1 - Enablement

Claims 25-34, 37, 38, 41 and 42 were rejected on the grounds that, while being enabling for the claimed steroids conjugated to NGF or a receptor-binding fragment of NGF, the specification assertedly

does not provide enablement for any binding fragment of any neurotrophin. This rejection is respectfully traversed as applied and as it may be applied to the pending claims.

Applicants maintain the position argued in the response filed August 7, 2003. In particular, the specification provides numerous examples of the neurotrophin component of the conjugates (see, e.g., specification page 16, line 14 to page 17, line 39) as well as a detailed description of the knowledge in the art regarding the structure of neurotrophins that provides guidance for suitable receptor-binding fragments (see, e.g., specification page 17, line 40 to page 18, line 29). Applicants also note that the specification provides guidance as to the position for conjugation within the amino acid sequence of such neurotrophins and fragments.

Furthermore, 4-pregnen-21-hydroxy or a 1,4-pregnadiene-21-hydroxy steroids within the scope of the claims are described in the specification, with guidance as to the 21 hydroxyl group from which the conjugant group pends, as recited in the present claims, including linkers that can be used to accomplish this conjugation (see, e.g., specification page 26, lines 9-16, and Tables 3 and 4).

However, in the spirit of expediting prosecution and without conceding as to correctness of the rejection, Applicants have amended Claims 25, 28, 29, and 35 to recite NGF or receptor-binding NGF fragment, rendering the rejection under 35 U.S.C. § 112, first paragraph, moot. As such, the Examiner is respectfully requested to withdraw this rejection.

Art of Interest

In an effort to expedite prosecution, applicants have obtained copies of the references cited in the document entitled "Art of Interest" and cited these in an Information Disclosure Statement submitted with this amendment.

The Office Action states at page 3:

Not all of the art of interest is pertinent in this situation since many of the references have been published after the filing date of the parent. The examiner will place pertinent references on a Form-892 in the next Office Action. However, the Examiner would like an explanation as to what the invention discloses over the prior art. As stands, it appears obvious to the artisan to produce conjugates of steroids and neurotrophins since these steroids affect at least neurotrophin expression (see for example 16 of 26 in the Art of Interest). Therefore, it appears obvious for the artisan to administer this conjugate in a patient who requires increased neurotrophins.

Applicants respectfully submit that it is difficult at best – and procedurally improper – for applicants to address the Art of Interest where no formal rejection has been made. However, solely in the

interest of expediting prosecution, applicants will address the comments made in the Office Action regarding the Art of Interest.

First, applicants respectfully submit that the comments in the Office Action appear to reflect a misunderstanding of the invention. For example, the Office comments that “it appears obvious . . . to produce conjugates of the steroids and neurotrophins since these steroids affect at least neurotrophins expression (see for example #16 of 26 on the Art of Interest).”

Applicants respectfully submit that the conjugate compounds of the present invention are designed to effect delivery of a steroid into a cell via binding of the neurotrophin receptor binding portion (e.g., NGF or NGF fragment).

In contrast, the art referred to in the Art of Interest packet (and now cited in the accompanying IDS), does not disclose or suggest such a conjugate, which provides for delivery of a steroid to a cell via binding of the neurotrophin receptor binding portion according to the present claims. In failing to teach or suggest such an element of the present invention, the art referred to in the Art of Interest packet cannot anticipate the present invention or render the present invention obvious.

Request for Interview

Applicants are grateful for the Examiner’s suggestion that they contact the Examiner to discuss the case in more detail. Once the Examiner has had the opportunity to consider the present amendment and the references cited in the IDS’ filed in the present application (including the IDS submitted with the present amendment), applicants respectfully request that the Examiner contact the undersigned so that an interview can be arranged should any issues remain.

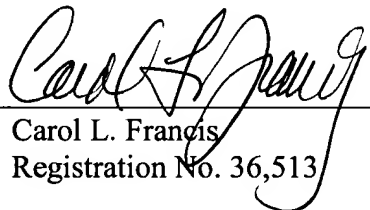
Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number ASIL-002CIP.

Respectfully submitted,
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Date: April 20, 2004

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